

REMARKS

This responds to the Office Action mailed on October 17, 2008.

Claims 1, 3 and 14, are amended.

Claims 2, 4-6, 10, and 12-13 are canceled.

Claims 1, 3, 7-9, 11, and 14-17 are now pending in this Application.

Drawing Objections

The Office Action objected to the drawings under 37 CFR 1.83(a). The Office Action states that the drawings must show every feature of the invention specified in the claims. The Applicants have Amended FIGS. 1-3 of the drawings, as suggested by the Examiner, to include descriptive text labels.

The Applicants believe that for amended claims 1, 3, and 14, the FIGS. 1-3, as amended, overcome the Office's 37 CFR 1.83(a) objection. As such, the Applicants respectfully request that the objection be reconsidered and withdrawn.

Specification Objections

The Office Action stated, "[a]pplicant is required to make appropriate amendments to the description to include "'machine-readable medium' as corresponding to 'storage mediums' provided no new matter is introduced."

The Applicants have canceled claim 13, rendering the specification objection moot.

§101 Rejection of the Claims

Claims 3, 7-9, 14-17 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claim 3

The Office rightly notes that regarding claim 3, the Applicants seek to patent a device comprising "means for" performing functions. The Office Action alleges that [a]ccording to the Applicant's specification, the Applicant intends for the means to comprise software means (see

Page 4, lines 4-7; page 6, lines 13-15, 27-29), and therefore, the claimed device is directed to a software device.”

The Office Action relies on the premise that the Applicants exclusively limit “means for” performing functions to software means. The Applicants respectfully submit that the Specification of the above referenced Application does not exclusively limit “means for” performing functions to software means.

The Applicants direct attention to page 10, lines 13-14 of the Applicants’ Specification, which recites “[i]n one embodiment, some or all parts of the client 101 are implemented as hardware modules, making them difficult to modify.” Since the Specification discloses hardware, in at least the above example embodiment, as being example “means for” performing functions, the Applicants respectfully submit that the Office’s above premise is false and that amended claim 3 overcomes the Office’s § 101 rejection. Accordingly, the Applicants respectfully request that the rejection be reconsidered and withdrawn.

Claim 14

The Office Action states, “[m]odules are software...and, therefore, the claimed device is directed to a software device.” The Applicants respectfully submit that the Office Action erroneously concludes that “modules” are exclusively limited to “software modules.”

For at least the reason that the Specification of the above referenced Application discloses example hardware modules, “modules” are not exclusively limited to “software modules.” Accordingly, amended claim 14 overcomes the Office Action’s § 101 rejection. The Applicants respectfully request that the rejection be reconsidered and withdrawn.

§112 Rejection of the Claims

Claim 13 was rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement.

The Applicants have canceled claim 13 rendering the Office Action’s § 112, first paragraph rejection moot.

Clarifying Amendments to Claims

The Applicants amend the claims indicated in the “In the Claims” section above to clarify the scope of the subject matter being claimed. Below, words added to the claims are underlined to indicate the amendment. The Applicants believe that the amendments to the claims add no new matter to this Application.

What is referred to in claims 1, 3, and 14, as a “multimedia object” is referred to as a “multimedia object file” in amended claims 1, 3, and 14. The claims dependent on claims 1 and 14 are likewise amended to include the “multimedia object file.”

Amended claim 1 now recites, “the device to perform at least a portion of one or more of the following acts.”

Amended claim 14 now includes various modules that are “configured to” perform various functionalities.

Claims 8 and 16 now recite, “registered usage information includes an indication of duration of media content associated with the multimedia object file.”

Remaining clarifying amendments are discussed below with respect to the Office Action’s §103 rejection.

§103 Rejection of the Claims

Claims 1 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levy et al. (U.S. 2007/029473) in view of Barnes, Jr. (U.S. 2007/0173266). Claim 13 is canceled rendering the §103 rejection of that claim moot. Claims 3 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Levy et al. (U.S. 2007/029473) in view of Levy (U.S. 2002/0052885) and Ishibashi (U.S. 7,353,541).

The applicable law recites that obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Supreme Court are: determining the scope and content of the prior art; resolving the level of ordinary skill in the pertinent art; and ascertaining the differences between the claimed invention and the prior art. (*Graham v. John Deere Co.*, 383 U.S. 1 (1966)).

An applicant is entitled to a patent unless “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

The Federal Circuit has stated that "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Applicants respectfully submit that the Levy applications, Barnes, and Ishibashi do not describe or suggest, alone or in combination, all of the elements of amended claims 1, 3, and 14.

The features of amended claims 1, 13, and 14 include the following (amendments underlined):

the user profile information including browsing behavior of the user to identify a multimedia interest of the user.

The Office Action alleges that paragraphs 234 and 235 of Barnes describe "the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user," of previously presented claims 1, 3, and 14. (Office Action, paragraph 22).

The cited portions of Barnes include the following:

[a]fter receiving an indication that the user has viewed the advertisement(s), that the advertisement(s) has been presented, that the user responded to an advertisement or taken desired or requested action (herein after collectively referred to as a user advertisement response), the ACS performs an incentive transaction.

Barnes, paragraph 234, lines 1-6 (emphasis added).

The Office Action alleges that a user in Barnes who indicates that the user has viewed an advertisement is providing user profile information or browsing behavior.

Regardless, Barnes at least does not disclose the feature of, "browsing behavior of the user to identify a multimedia interest of the user." Even assuming *arguendo* that selecting an advertisement in Barnes is the same as browsing behavior, Barnes does not describe any selected advertisement "**to identify a multimedia interest of the user,**" as required by amended claims

1, 3, and 14. In fact, indication of an advertisement in Barnes only results in performance of an “incentive transaction” that “provides the user with some form of direct or indirect financial gain.” (Paragraph 235, lines 1-2). Barnes’ performance of an “incentive transaction” is clearly not the same as “browsing behavior of the user to identify a multimedia interest of the user.”

For the reasons explained above, the cited references alone or in combination at least fail to describe, “browsing behavior of the user to identify a multimedia interest of the user,” of claims 1, 3, and 14. As such, the amended claims 1, 3, and 14 overcome the Office Action’s § 103 rejection of previously presented claims 1, 3, and 14.

Claims 7-9, 11; and 15-17 depend from amended claims 3 and 14 are overcome the rejections for at least the same reasons explained with respect to amended claims 3 and 14. Accordingly, the Applicants respectfully request that the Office Action’s § 103 rejections be reconsidered and withdrawn.

CONCLUSION


Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4041 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

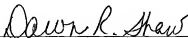
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(408) 278-4041

Date 2/17/2008

By 
Garth Vivier
Reg. No. 57,313

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 17, 2009.

Dawn R. Shaw
Name


Signature